

## **REMARKS**

Reexamination and reconsideration of this application as amended is requested. By this amendment, Claims 1, 5, 6, 8, 9, 11, 15, 18, 21, 25, 28, 32, 33, 35, 36, and 38, have been amended, and Claims 7, 24, and 34 have been cancelled. After this amendment, Claims 1-6, 8-23, 25-33, and 35-39 remain pending in this application.

### **Overview of the Present Invention**

The present invention is a system and method for user-specified error correction in an instant messaging system. The invention utilizes at least two client systems that are communicatively coupled to an instant messaging manager on a messaging server system via a network. Page 4, lines 13-15 of the present application. Therefore, there are at least three participating components in the present invention: a transmitting device, a message server, and a recipient device. The messaging server system contains **an instant message manager** and controls the flow of messages between the client systems. Page 5, lines 1-3 of the instant application.

FIGs. 4-6 of the instant application show the operational flow of the present invention, where message corrections initiated at the transmitting client device and the correction instructions ("message correction specification") are routed to the message manager residing on the messaging server. See FIG. 4, steps 410-412. The messaging server then determines whether or not the message has been transmitted to the receiving client and either corrects the message before sending it **by following the message correction specification**, or forwards the corrections to the receiving client device if the message has already been sent. See also the specification, Pages 7-12. Finally, the receiving client device checks to see if the message is a correction

and, if it is, retrieves the original message from the conversation log, corrects it, and alerts the user that a correction has been submitted.

## **(2) Claim Rejections - under 35 USC § 102 Svoboda**

In item 2 on page 2 of the Office Action, the Examiner rejected Claims 1-4, 15, and 28-31 under 35 U.S.C. 102(e) as being anticipated by Svoboda (U.S. Patent No. 6,597,771).

### **Claims 1 and 28:**

Applicant has amended Claims 1 and 28 to more clearly and distinctly recite the present invention. Support for this amendment may be found in the specification as originally filed, see for example page 2, lines 20-23, FIG. 4 step 412, and FIG. 5, step 512. No new matter was added.

Before further discussing the Svoboda reference, it is believed that a brief review of amended claim 1 would be helpful. Claim 1 states, *inter alia*:

accepting, with an instant messaging originating device, a correction to a message previously sent from the instant messaging originating device and destined for reception by an instant messaging recipient device;

determining, with the instant messaging originating device, that a message correction of the previously sent message requires sending a message correction specification; and

based on the determination of message correction of the previously sent message, sending from the instant messaging originating device to an instant message manager on an instant messaging server the message correction specification that specifies a correction of the previously sent message.

### **Overview of the Svoboda Reference**

The Svoboda reference teaches a method performed **directly** between **two** devices—a transmitter communication unit and a receiver communication unit. The focus of the Svoboda invention is on a password that contains information regarding the identity of a sender of a message and works “as a key for obtaining an access to functions of modification and/or deleting a message having been stored.” *See, for example*, claim 1 of Svoboda.

The transmission unit and receiver unit of Svoboda are coupled through a network, such as the internet. Svoboda, col. 2, lines 53-63. Each of the transmission unit and the receiver unit are “connected to a storage unit, e.g. a mail server.” Svoboda, col. 2, lines 56-57. Importantly, Svoboda does not discuss any purpose or functionality of the “mail server” other than as merely a storage space. **Therefore, the “mail server” of Svoboda does not have functionality for message correction or replacement** as does the novel routing server of the present invention. Svoboda states only that the password will grant access to the sender for modifying or deleting a message stored in the communication unit of the receiver. In short, **Svoboda does not teach or explain a messaging server or its functions as claimed for the present invention.** Therefore, Svoboda does not show “a message correction specification” and because the message server in Svoboda has no functionality other than to store files, Svoboda certainly does not show a “message correction specification that specifies a correction of the previously sent message” as recited in claim 1 of the instant application.

The Examiner states that Svoboda anticipates claim 1 and cites, on page 3 of the Office Action, col. 1, lines 17-27 and col. 2, lines 5-62 as showing a message correction specification. However, only a sender’s ability to access the storage database via a password to “allow the **sender** to change or delete the

message" is disclosed. There is no sending of a message correction specification in Svoboda.

The Examiner also cites col. 1, lines 57-67 and col. 3, lines 5-26 of Svoboda, which states: *"after receiving a message, the message being delivered into a receiver communication unit through data communication means and stored in a storage unit, there is a password allocated to the sender, the password being allocated with respect to available information about an identity of the sender, and the password is delivered back to the transmitter communication unit as acknowledgement message and serves the sender as a key for obtaining an access to functions for modification and/or deleting a message stored in a communication unit of the receiver."* (emphasis added) All of the message editing functionality of Svoboda and all of the language quoted by the Examiner is describing functions performed by the sender accessing the receiving unit to modify and/or delete an email message stored in a storage area of the *receiving* unit. Claim 1 of Svoboda recites "a key for obtaining an access to functions of modification and/or deleting a message having been stored in the receiver communication unit." There is no instant messaging server and no functionality at an instant messaging server disclosed by Svoboda. Svoboda is silent as to the specific method used by the sender while accessing the storage area of the destination email server unit to modify and/or delete stored email messages. However, it is evident that the sender is actively accessing (after entry of a password) editing functions in the receiving unit (email server) to modify and/or delete stored messages in the storage area of the email server.

Claim 1, of the presently claimed invention, is written from the point of view of an instant messaging originating device and has been amended to clarify the transmission of the message correction specification to an instant message manager on an instant messaging server. Because Svoboda does not have an instant message manager and because editing functions of the email server of

Svoboda are actively accessed by the sender (after entry of a password) for correcting previously stored email messages, the method of the instant messaging originating device sending a "message correction specification that specifies a correction of the previously sent message" is missing from Svoboda. Svoboda describes passwords and password access to the storage area on the receiving unit so that the sender can gain access to the editing functions in the destination email server unit and then modify and/or delete the erroneously sent email message stored in the email server unit.

Because all of the correction functionality of Svoboda is performed by the sender actively accessing the editing functions at the destination email server unit, Svoboda is silent on sending a "message correction specification that specifies a correction of the previously sent message" as recited for claim 1 of the present application.

Claim 28 recites the same method steps as does claim 1. However, the method steps in claim 28 are in the form of instructions on a computer readable medium.

The Examiner also rejects claim 15. However, the Examiner fails to particularly point out where each element of claim 15 is found in the Svoboda reference. As explained in detail above, Svoboda discloses a mail server that is part of the recipient device, where the mail server is accessible to the sender via a password to allow the sender to replace or modify the file. Svoboda also discloses an optional function of its receiver unit, which is to analyze the received message and, when finding its parameters unsatisfactory or different from desired ones, demanding the sender to modify the message. Svoboda, col. 3, lines 23-26.

Nowhere, however, does Svoboda disclose an error corrector, communicatively coupled to the instant messaging client, for accepting a correction to an instant message that was previously sent from the instant messaging client, determining whether a message correction of the previously sent instant message requires sending from the instant messaging client a message correction specification that specifies a correction to the instant message that was previously sent from the instant messaging client, and based on the determination of message correction of the previously sent message, sending to an instant messaging server the message correction specification.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.<sup>1</sup> Because the elements in independent claims 1, 15, and 28 (at least a “message correction specification that specifies a correction of the previously sent message” and “error corrector, communicatively coupled to the instant messaging client, for accepting a correction to an instant message that was previously sent from the instant messaging client, determining whether a message correction of the previously sent instant message requires sending from the instant messaging client a message correction specification that specifies a correction to the instant message that was previously sent from the instant messaging client, and based on the determination of message correction of the previously sent message, sending to an instant messaging server the message correction specification”) of the instant application are not taught or disclosed by Svoboda, the apparatus of Svoboda does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claims 1, 15 or 28, respectively. Accordingly, the present invention distinguishes over Svoboda for at least this reason. The

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<sup>1</sup> See MPEP §2131 (Emphasis Added) “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.”

Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome. The Examiner should withdraw the rejection of the claims.

**(3) Claim Rejections - 35 USC § 103 Maurille in view of Svoboda**

The Examiner rejected 5-6, 9-12, 18, 21, 24, 25, 32-33, and 36-38 under 35 U.S.C. 103(a) as being unpatentable over Maurille (U.S. Patent No. 6,484,196) in view of Svoboda (U.S. Patent No. 6,597,771).

Dependent claim 24 was cancelled without prejudice.

**Claims 5 and 32:**

Independent claim 5 recites, *inter alia*:

A method "performed by an instant message manager on a messaging server, the method comprising  
receiving, at an instant messaging server, a message correction specification and a message identifier (ID) from an instant messaging originating client system, wherein the message correction specification comprises at least one text replacement specification that specifies a correction to an instant message that was previously sent from the instant messaging originating client system; and  
sending, from the instant messaging server, the message correction specification and the message ID to an instant messaging recipient client system if an instant message with a corresponding message ID has previously been sent from the instant messaging server to the recipient client system."

Claim 5 recites a method performed by an instant message manager on a messaging server. Claim 32 of the instant application, recites the same method steps stored on a computer readable medium.

Maurille discloses many elements of an instant messaging system. However, as the Examiner correctly recognizes on page 4 of the Office Action,

Maurille does not show "*accepting a correction to a previously sent message*". In fact, Maurille does not disclose message correction at all. Because Maurille does not disclose instant message correction, it follows, therefore, that Maurille also does not disclose *receiving a message correction specification or sending the message correction specification and the message ID to an instant messaging recipient client system*. The Examiner goes on to combine Svoboda.

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Svoboda mentions a "mail server" but is completely silent on the purpose or functionality within that device. Svoboda, col. 2, line 57. As explained in detail in the section above entitled (2) Claim Rejections - under 35 USC § 102 Svoboda, Svoboda only discloses message correction as performed by the sender himself. Svoboda, col. 3, lines 19-22. Because all of the correction functionality of Svoboda is performed by the sender, Svoboda is completely silent on "*a method performed by an instant message manager on a messaging server*" and is also silent on "*a message correction specification*" as recited in claims 5 and 32 of the instant application.

Therefore, Maurille, whether taken alone or in any combination with Svoboda, neither shows nor suggests the features of claims 5 or 32. The Examiner should withdraw the rejection of these claims.

Claims 6 and 33:

With regard to independent claims 6 and 33 of the instant application, claims 6 and 33 recite, *inter alia*:

receiving, at an instant message manager on a messaging server, a message correction specification and a message identifier (ID) from an instant messaging originating client system, wherein the message correction specification comprises at least one text replacement specification that specifies

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<sup>2</sup> Applicants make no statement as to whether such a combination is even proper.

a correction to an instant message that was previously sent from the instant messaging originating client system;

correcting, with the instant message manager on the messaging server, a message with a corresponding message ID if a message with a corresponding message ID has not previously been sent to an instant messaging recipient client system, wherein the message with the corresponding message ID being found in an ephemeral storage system communicatively coupled with the instant message manager on the messaging server and that stores a log of the instant messages in a discussion between the instant messaging originating client system and the instant messaging recipient client system, and further wherein the correcting is based on the received message correction specification; and

sending the corrected message and the message ID to the instant messaging recipient client system.

Claim 6 recites that the method is performed by an instant message manager on a messaging server and claim 33 recites the method steps being stored on a computer readable medium.

Maurille discloses many elements of an instant messaging system. However, as the Examiner correctly recognizes on page 4 of the Office Action, Maurille does not show "*accepting a correction to a previously sent message*". In fact, Maurille does not disclose message correction at all. Because Maurille does not disclose instant message correction, it follows, therefore, that Maurille also does not disclose *receiving a message correction specification* and especially does not disclose *correcting a message... and sending the corrected message* to the instant messaging recipient client system. The Examiner goes on to combine Svoboda.<sup>3</sup>

Svoboda mentions a "mail server" but is completely silent on the purpose

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<sup>3</sup> Applicants make no statement as to whether such a combination is even proper.

or functionality within that device. Svoboda, col. 2, line 57. Svoboda only discloses message correction as performed by the sender itself by accessing editing functions of the email server unit. See, for example, Svoboda, col. 3, lines 19-22. Because all of the correction functionality of Svoboda is performed by the sender accessing functions at the destination email server unit, Svoboda is completely silent on, and does not teach, anticipate, or suggest, a *method performed by an instant message manager on a messaging server and further receiving a message correction specification...correcting a message...and sending the corrected message*, in accordance with the recitation of claims 6 and 33 of the instant application.

It is accordingly believed that Maurille, whether taken alone or in any combination with Svoboda neither shows nor suggests the features of claims 6 or 33. The Examiner should withdraw the rejection of these claims, and dependent claims depending therefrom, respectively.

Claims 9 and 36:

Independent claims 9 and 36 recite, *inter alia*:

- maintaining an ephemeral storage log of an instant messaging conversation;
- receiving a message correction specification and a message identifier (ID) from an instant messaging originating client system;
- determining if a message processing service is required for the received message correction specification;
- correcting, based on the received message correction specification, a message with a corresponding message ID in the ephemeral storage log if a message processing service is required; and
- sending the corrected message and the message ID to an instant messaging recipient client system.

Claim 9 recites method steps for correcting a message, which, as the Examiner correctly recognizes on page 4 of the Office Action, is not performed by Maurille. Claim 36 recites the method steps being stored on a computer readable

medium The Examiner goes on to combine Svoboda.<sup>4</sup>

The method, as claimed, is performed by an instant message manager on a messaging server. As stated above, all of the message-editing functionality of Svoboda and all of the language quoted by the Examiner on page 3 of the Office Action is describing functions performed by the sender accessing editing functions at the destination email server unit.

The steps recited in claims 9 and 36 describe an instant message manager on a messaging server correcting a message *prior to* sending it to the recipient client system. Svoboda is completely silent on this method, as recited in claims 9 and 36 of the instant application.

Therefore, Maurille, whether taken alone or in any combination with Svoboda neither shows nor suggests the features of claims 9 or 36. Claims 9 and 36 are, therefore, believed to be patentable over the art. The dependent claims 10 and 37 are believed to be patentable as well because they are dependent on claims 9 and 36, respectively. The Examiner should withdraw the rejection of these claims.

Claims 11 and 38:

Independent claims 11 and 38 recite, *inter alia*:

receiving, at an instant messaging recipient client system, a message correction specification and a message identifier (ID) from [[a]] an instant messaging server;

retrieving, in response to the receiving, [[a]] an instant message with a corresponding message ID from a conversation log that stores a log of the instant messages in a discussion between the instant messaging recipient client system and an instant messaging originating client system;

correcting the retrieved instant message based on the message correction specification;

updating the conversation log with the corrected instant message; and

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<sup>4</sup> Applicants make no statement as to whether such a combination is even proper.

activating an alert to notify a user of an update to the conversation log with the corrected instant message.

Claims 9 and 11 recite method steps for correcting a message, which, as the Examiner correctly recognizes on page 4 of the Office Action, is not performed by Maurille. Therefore, Maurille doesn't disclose "*receiving a message correction specification*", "*correcting the message*", and certainly does not disclose "*activating an alert to notify a user of an update* to the conversation log **with the corrected instant message.**" The Examiner goes on to combine Svoboda.<sup>5</sup>

Svoboda discloses messages that are sent to a receiving client device and then deposited in a storage unit. Svoboda, col. 2, lines 50-62. The invention of Svoboda allows a user of the sending device to cause the message in the storage unit to be edited or deleted. Svoboda, col. 2, lines 24-31. Importantly, however, Svoboda is completely silent on "*receiving a message correction specification*" and "*activating an alert to notify a user of an update* to the conversation log **with the corrected instant message.**" In fact, Svoboda specifically states that the "invention allows the sender to change or delete the message **without bothering the addressee** with an invalid message." Svoboda, col. 2, lines 31-33. Therefore, Svoboda actually and expressly *teaches away* from the novel method presently claimed because the sender in Svoboda is the one making the changes **without bothering the addressee** and, as a result *teaches away* from the presently claimed method, as recited for claims 11 and 38 of the instant application.

Additionally, Maurille and Svoboda are silent on updating a conversation log with a corrected instant message as recited for claims 11 and 38 of the instant application.

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<sup>5</sup> Applicants make no statement as to whether such a combination is even proper.

It is accordingly believed that Maurille, whether taken alone or in any combination with Svoboda neither shows nor suggests the features of claims 11 or 38. Claims 11 and 38 are, therefore, believed to be patentable over the art. The dependent claims 12 and 39 are believed to be patentable as well because they are dependent on claims 11 or claim 38, respectively. The Examiner should withdraw the rejection of these claims.

Claim 21:

Independent claim 21 recites, *inter alia*:

an error corrector, communicatively coupled to the instant message manager, for receiving a message correction specification and a message identifier (ID) from an instant messaging originating client system, correcting a message with a corresponding message ID if the error corrector determines from a system configuration parameter to apply server-side message processing to instant messages, wherein the message with the corresponding message ID being found in the ephemeral storage system, and sending the corrected message and the message ID to the instant messaging recipient client system.

Claim 21 recites "an error corrector." The Examiner, on page 4 of the Office Action states that "Maurille does not show accepting a correction to a previously sent message." Therefore Maurill does not teach or suggest an error corrector as recited for claim 21. The Examiner goes on to combine Svoboda.<sup>6</sup>

As stated above, Svoboda discloses all error correcting being performed by the sender accessing editing functions at the destination email server unit. Svoboda, col. 3, lines 19-22. Svoboda does **not** teach or suggest an instant message manager, an error corrector with error correction specifications, or a server that corrects messages and sends the corrected instant message to the instant messaging recipient client device. Claim 21, however, recites an error

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<sup>6</sup> Applicants make no statement as to whether such a combination is even proper.

corrector being located at an instant message manager, where the error corrector receives a correction specification, corrects the message, and then sends the corrected message and the message ID to the instant messaging recipient client system.

It is accordingly believed to be clear that Maurille, whether taken alone or in any combination with Svoboda neither shows nor suggests the features of claim 21. Claim 21 is, therefore, believed to be patentable over the art. Dependent claim 24 was cancelled. The Examiner should withdraw the rejection of claim 21 and dependent claims depending therefrom.

Claim 25:

Claim 25 recites, *inter alia*:

an instant messaging server, communicatively coupled to the at least one instant message originating client system, for receiving a message correction specification and a message identifier (ID) from the at least one originating client system, and sending the message correction specification and the message ID to the recipient client system.

The Examiner, on page 4 of the Office Action states that "Maurille does not show accepting a correction to a previously sent message". It follows then, that Maurille does not show, teach, or suggest the presently claimed system. The Examiner goes on to combine Svoboda.<sup>7</sup>

As stated above, Svoboda discloses all error correcting being performed by the sender accessing editing functions at the destination email server unit. See, for example, Svoboda, col. 3, lines 19-22. Svoboda does not teach or suggest an instant message server or a server that receives a message correction specification and a message identifier (ID) from the at least one originating client system and then sends the message correction specification and the message ID

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<sup>7</sup> Applicants make no statement as to whether such a combination is even proper.

to the recipient client system, as recited in accordance with the claim language of claim 25.

It is therefore believed that Maurille, whether taken alone or in any combination with Svoboda neither shows nor suggests the features of claim 25. The Examiner should withdraw the rejection of claim 25 and dependent claims depending therefrom.

**(4) Claim Rejections - 35 USC § 103 Maurille in view of Svoboda and Rayson et al.**

The Examiner rejected Claims 3-4, 7-8, 10, 13-14, 16-17, 19-20, 22-23, 26-27, 30-31, 34-35, and 37 under 35 U.S.C. 103(a) as being unpatentable over Svoboda (U.S. Patent No. 6,597,771) and Maurille (U.S. Patent No. 6,484,196) and further in view of Rayson et al. (U.S. Pat. No. 5,761,689).

Claims 7 and 34 were cancelled without prejudice.

Rayson discloses a standard word processing system for automatically replacing one or more characters of text entered by a user in a word processing document. Rayson, abstract. Rayson is not concerned with the Internet or the correction of instant messages that have previously been sent.

In the section entitled "(2) Claim Rejections - under 35 USC § 102 Svoboda" above, the deficiencies of the messaging system disclosed in the Svoboda reference were discussed. In the section entitled "(3) Claim Rejections - 35 USC § 103 Maurille in view of Svoboda" above, the deficiencies of the messaging system disclosed in the Maurille reference in view of the Svoboda reference were discussed. These arguments will not be repeated here. The

Rayson reference does not teach, anticipate, or suggest any of the deficiencies of the Svoboda and Maurille references as has been discussed above.

Accordingly, in view of the discussions above, neither Rayson, Maurille, Svoboda, nor any combination thereof, teaches, anticipate, or suggests the presently claimed method, apparatus, system, and computer readable medium, as recited for the present pending claims.

Applicants additionally submit that for a proper combination of the references Svoboda, Maurille, and Rayson, a motivation would have indeed had to been necessary as suggested by the references themselves which the Examiner would have the burden to prove. A purely general remark towards the known advantageous material characteristics of word processing functionality in Rayson is insufficient in order to justify a rejection under 35 U.S.C. § 103 based on an arguable combination of these references. In order to establish a prima facie case of obviousness by modifying or combining reference teachings, MPEP § 2143 requires that:

- there must be some suggestion or motivation to combine the references in the prior art;
- there must be a reasonable expectation of success to be found in the prior art; and
- the prior art references must teach or suggest all the claim limitations.

It is believed that not one of the three criteria has been met.

Accordingly, in view of the amendments and remarks above, since neither Maurille, Svoboda, Rayson, nor any combination of the three cited references, teaches, anticipates, or suggests, the presently claimed invention, Applicant believes that the rejection of claims 3-4, 7-8, 10, 13-14, 16-17, 19-20, 22-23, 26-27, 30-31, 34-35, and 37 under 35 U.S.C. 103(a) has been overcome. The Examiner should withdraw the rejection of these claims.

### **Conclusion**

The foregoing is submitted as full and complete response to the Official Action mailed May 22, 2006, and it is submitted that Claims 1-6, 8-23, 25-33, and 35-39 are in condition for allowance. Reconsideration of the rejections is requested. Allowance of Claims 1-6, 8-23, 25-33, and 35-39 is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicant acknowledges the continuing duty of candor and good faith to disclose information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and the attorneys.

**If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.**

Additionally, a petition for extension of time to file this Response is hereby incorporated herein. The Commissioner is authorized to charge the extension fee of **\$450**, or if this fee amount is insufficient or incorrect, then the Commissioner is authorized to charge the appropriate fee amount to prevent this application from becoming abandoned, to Deposit Account **50-1556**.


The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account **50-1556**.

In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

Respectfully submitted,

Date: October 23, 2006

By: \_\_\_\_\_

  
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